

**REMARKS****Summary of the Office Action**

Claims 14-26 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite.

Claims 14-18 and 22-26 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Norgaard et al. (WO 01/92859) (hereinafter “Norgaard”).

Claims 19-21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Norgaard in view of Yan et al. (CN Patent No. 101281131-Abstract Only) (hereinafter “Yan”).

**Summary of the Response to the Office Action**

Applicants have amended claims 14, 15 and 23 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. Accordingly, claims 1-32 remain currently pending with claims 14-26 currently under consideration.

**Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 14-26 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. Applicants have amended claims 14, 15 and 23 in response to the Examiner’s comments at page 3, section 6 of the Office Action to improve the form of the claims. Applicants respectfully submit that all of the currently pending claims, as amended, fully comply with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

**Rejection under 35 U.S.C. §§ 102(b) and 103(a)**

Claims 14-18 and 22-26 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Norgaard. Claims 19-21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Norgaard in view of Yan. Applicants have amended independent claim 14 to differently describe embodiments of the disclosure of the instant application. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, the rejections are respectfully traversed for at least the following reasons.

Applicants respectfully submit that Norgaard discloses an arrangement in which three latent variables are obtained by way of weighted averages of a 3 way tensor and assesses the sample by the latent variables. See page 34, etc. of Norgaard.

On the other hand, Applicants respectfully submit that the present invention discloses an advantageous combination of features, as described in newly-amended independent claim 14, in which a specific point is detected in the three-dimensional (3-D) optical spectrum and assesses a sample based on an attribute of the specific point. Examples of the attributes of the specific point are listed in dependent claim 15 of the instant application.

Nevertheless, Applicants have opted to amend independent claim 14 of the instant application to even further distinguish from the applied Norgaard reference. In particular, Applicants have amended independent claim 14 to describe an advantageous combination of features in which the previously-claimed “specific point” is described as being “a relative maximum peak or a relative minimum peak of a fluorescence intensity.” See, for example, paragraphs [0071] and [0096] of the specification of the instant application in this regard.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Norgaard does not teach or suggest each feature of

independent claim 14 of the instant application, as newly-amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)."

Furthermore, Applicants respectfully assert that the dependent claims 15-26 are allowable at least because of their dependence from newly-amended independent claim 14 and the reasons discussed previously.

**Applicants respectfully request that the applied secondary reference to Yan be withdrawn in the next Office Communication because it's publication date of October 8, 2008 does not qualify it as prior art against the instant application.** If Applicants' understanding is incorrect in this regard, clarification is respectfully requested to be provided by the Examiner in the next Office Communication.

### **CONCLUSION**

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response; the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF**

**TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**DRINKER BIDDLE & REATH LLP**

Dated: February 23, 2009

By:

A handwritten signature in black ink, appearing to read 'Paul A. Fournier', written over a horizontal line.

Paul A. Fournier

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